

Appl. No. 10/719,319  
Amdt. dated December 15, 2005  
Reply to Final Office Action of September 15, 2005

### **REMARKS/ARGUMENTS**

Applicants acknowledge receipt of the Final Office Action dated September 15, 2005. In the Final Rejection, Claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Application No. 2004/0068148 to Allison et al (hereinafter the “the ‘148 publication”). Also, Claims 17, 22 and 23 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Application No. 2004/0225165 to Allison et al (hereinafter “the ‘165 publication”). Finally, Claims 1-7, 10-14, 18-21, and 24-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘165 publication.

#### **I. Status of the claims.**

Claims 1-30 are pending in the application.

By this Response, Applicants have amended Claims 1, 17 and 20.

Claims 2-16, 18, 19 and 21-30 stand as originally filed.

#### **II. Disqualification of the ‘148 publication based on 35 U.S.C. §103(c)(1)**

In the Final Office Action dated September 15, 2005, Claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘148 publication. This same rejection was issued in the prior Official Action and the Examiner noted that the rejection was being maintained in this Final Rejection because the requirements of 35 USC 103(b)(1) were not met by Applicants in their prior Response. The Examiner indicated that Applicants had not provided a separate statement regarding common ownership at the time this invention was created. In reviewing the rules in the MPEP regarding this, it appears that the only requirement is that it be conspicuous so that the Examiner quickly notices the statement. The rules suggest that it can be done on a separate piece of paper or

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in a separately labeled section. In Applicants Response to the First Office Action, the entire Remarks Section was on one page and was focused almost entirely of arguments about 103(c)(1). Applicants believed at the time that this was fully conspicuous. The Examiner certainly noticed Applicants argument regarding common ownership although there is no indication as to whether this was quickly noticed. Most importantly, there is nothing in the Final Office Action that would appear to suggest that there is any dispute as to whether the present invention and the reference were commonly owned at the time the present invention was made. In response, Applicant has attempted to make the statement as clear and conspicuous as possible by presenting the attached Statement Regarding Common Ownership on a separate piece of paper. Applicants fully believe that this raises no new issue for consideration and the '148 publication should now be precluded as prior art under 35 U.S.C. § 103(c)(1).

### III. Disqualification of the '165 publication based on 35 U.S.C. §103(c)(1)

With regard to the newly cited '165 publication, Applicants' attached Statement Regarding Common Ownership for the '148 publication also addresses this '165 publication. In support of the Statement, it is noted that the '165 reference was not published until November 11, 2004, which is after the filing date of the present application (November 21, 2003), the '165 publication is only citable under §103 in combination with §102(e). The subject matter of the patent application '168 publication with USPTO Serial No. 10/436,684 and the claimed invention of the present patent application with USPTO Serial No. 10/719,319 were commonly owned and subject to an obligation of assignment to the same company, at the time the claimed invention was made. Both the present application and the '165 publication both have been assigned to ConocoPhillips Company. The assignment of the '165 publication to ConocoPhillips Company was recorded at

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Reel/Frames 014483/0670 and 015255/0071, and the assignment of the present application to ConocoPhillips Company was recorded at Reel/Frame 015193/0231. Hence, the requirements of § 103(c)(1) are believed satisfied, and the '165 publication should now be precluded from serving as the basis for an obviousness rejection to the present claimed invention.

#### IV. Rejections based on 103(a)

In the Final Office Action dated September 15, 2005, Claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '148 publication, and Claims 1-7, 10-14, 18-21, and 24-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '165 publication. As stated above, both the '148 publication and the '165 publication are precluded from serving as the basis for an obviousness rejection to the present claimed invention, based on 35 U.S.C. §103(c)(1). No new consideration by the Examiner should be required at this time as this is the same issue as was raised by Applicants in the prior Office Action for the other reference. Thus, Applicants respectfully request the Examiner to withdraw the obviousness rejections of the present claims.

#### V. Rejections based on 102(e)

In the Final Office Action dated September 15, 2005, Claims 17, 22 and 23 are rejected under 35 U.S.C. §102(e) as being unpatentable over the '165 publication. Claim 17 is an independent claim and Claims 22 and 23 both depend from Claim 17. At this time while this Application is under final rejection, Applicant does not intend to raise any new issues requiring additional consideration. What Applicants intend to do is modify Claim 17 to include subject

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matter set forth in Claim 20. Since Claim 20 should be allowable in light of the preclusion of the references as prior art under 103(c)(1), Applicants believe and assert that no further consideration is incumbent upon the Examiner and that Claim 17 is therefore allowable as now amended. Further, the dependent Claims from 17 which include the rejected Claims 22 and 23 should also now be immediately allowable.

#### VI. Claim 20 amendment

As to Claim 20, Applicants further amended Claim 20 to recite "wherein the catalyst has a molar ratio of copper to manganese of about 1:10 or higher", in order to cover an additional embodiment to which Applicants are entitled. The amendment of Claim 20 narrowed the scope of the originally filed Claim 20, is supported by the patent application as originally filed, for example in paragraph [0019], and is dependent of what should be allowable base claim as it carries all the limitations of such independent claim.

#### VII. Claim 1 amendment

Claim 1 was rejected under 103(a) as being unpatentable over the '148 publication, and further under 35 U.S.C. §103(a) as being unpatentable over the '165 publication. However, as stated above, both the '148 and '165 publications do not qualify as prior art based on 35 U.S.C. §103(c)(1).

In the review of the claims in preparation of this reply, Applicants noticed that Claim 1 recites "a molar ratio of copper to the base metal *greater than about 1:10*", whereas Claim 2 dependent from Claim 1 recites "wherein the molar ratio of copper to the base metal is *between*

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about 1:10 and about 1:2". Since Claim 2 covers a molar ratio of copper to the base metal of about 1:10 which is broader than required in Claim 1, Applicants amended Claim 1 by reciting "a molar ratio of copper to the base metal of about 1:10 or higher", to provide support for the molar ratio of copper to the base metal of about 1:10 in Claim 2. This amendment is supported by the specification as filed, for example by paragraph [0019], which reads:

"....The molar ratio of copper to the base metal is preferably about 1:20 or higher, more preferably about 1:10 or higher, and yet still more preferably between about 1:10 and about 1:2...."

Applicants submit that no new matter was introduced by way of amendment to Claim 1, and that this amendment does not raise new issues that would require further consideration and/or search. Applicants believe that Claim 1, as amended, is patentable over the cited art, and Applicants respectfully request allowance of amended Claim 1.

### VIII. Conclusion

For the reasons stated above, Applicants believe that all of the pending claims are patentable, and that this amendment places the application in condition for allowance. Applicants submit that *no new matter was introduced* by way of amendment to the claims, and that this amendment *does not raise new issues* that would require further consideration and/or search.

If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore. If any fee is due, please appropriately charge such fee to Deposit Account Number 16-1575 of ConocoPhillips Company, Houston, Texas.

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Should there be any remaining issue which the Examiner believes would possibly be resolved by a conversation, the Examiner is invited to call the undersigned at (580) 767-4958 so that further delay in a Notice of Allowance can be avoided. Also, if the Examiner is not persuaded that the Application is in condition for allowance and is not believing that whatever issues remaining can be resolved by a telephone interview, the Examiner is requested to at least approve entry of the amendments as they will clearly put this Application in better form for appeal by reducing issues for appeal.

Respectfully submitted,



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David W. Westphal  
USPTO Reg. No. 32,673  
ConocoPhillips Company  
P. O. Box 1267  
Ponca City, Oklahoma 74602-1267  
ATTORNEY FOR APPLICANT

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